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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,575	11/08/2001	Jay S. Walker	96-060-C1	3457

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EXAMINER

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3692

MAIL DATE	DELIVERY MODE
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12/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/006,575

Applicant(s)

WALKER ET AL.

Examiner

Clement B. Graham

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 79-101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 79-101 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-6, 7-47, 50-78, has been cancelled and 79-101 remained pending.

**Claim Rejections - 35 USC § 101**

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 83-85, 91-95, 99-100, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant's claims are directed to an algorithm. Specifically, claim **82-85, 91-95, 99-100**, recites "associating", "receiving" and "charging" register, however these steps are mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, for example) and abstract ideas without a practical application are found to be non-statutory subject matter. Therefore, Applicant's claims are non-statutory as they do not produce a useful, concrete and tangible result.

***Claim Rejections - 35 USC § 112***

3 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 79, 83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, Claims 79, 83, recites the states ["associating in a database a credit card account number and a serial number of a payment draft and receiving from a user information including the credit card account number, the serial number of the payment draft, and a face value"].

However this language fails to distinctly claim Applicant's invention because the scope of the claims is unclear because how can one associate in a database a credit card account number and a serial number of a payment draft with out storing the information first????..... . Moreover the specification fails to clarify, the meaning of the limitation. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 79-101, are rejected under 35 U.S.C. 103(a) as being unpatentable over by Berger U.S Patent 5, 477, 037) in view of Ginter US Patent No: 6, 658, 568.

As per claim 79, Berger discloses a method, comprising:  
associating in a database ("i. e, host data center with a database") a credit card account number and a serial number of a payment draft (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40)  
receiving from a user information including the credit card account number, the serial number of the payment draft, and a face value ("i. e, "this data would have been inherently documented when a purchase has been made" see column 4 lines 41-67 and column 5 lines 1-3 and 14-40)  
registering the face value in association with the serial number ("i. e, "this data would have been inherently documented when a purchase has been made" see column 4 lines 41-67 and column 5 lines 1-3 and 14-40)  
receiving the indication("i. e, verification") and serial number and the face value of the payment draft, and charging a credit card account associated with the credit card account number .(see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

Berger fail to explicitly teach third party.

However Ginter discloses FIG. 16B shows that the usage clearinghouse may also provide services to other Commerce Utility Systems . In one example, the usage clearinghouse may provide raw data, aggregated data, at least in part derived information, and/or reports to other electronic commerce support services such as financial clearinghouses, rights and permissions clearinghouses, certifying authorities, secure directory services, transaction authorities, and other usage clearinghouses..(see column 104 lines 48-67 and column 105 lines 1-13).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger to include third party taught by Ginter in order to verify transactions.

As per claim 80, Berger discloses in which receiving an indication from the third party further comprises:

determining if the serial number and face value information matches stored data; and transmitting a verification code to the third party to validate the payment draft if the received information matches the stored data. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 81, Berger discloses in which receiving user information further comprises receiving at least one of a plurality of face value amounts, a plurality of serial numbers, a number of payment drafts desired, and a date. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 82, Berger discloses further comprising: determining if the user is found in a membership database; and prompting the user to register a copy of payment draft software if the user is not found in the membership database. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 83, Berger discloses a computer readable medium storing instructions configured to direct a processor to:

associate in a database("i. e, host data center with a database") a credit card account number and a serial number of a payment draft(see column 4 lines 41-67 and column 5 lines 1-3 and 14-40)

receive from a user information including the credit card account number, the serial number of the payment draft, and a face value("i. e, "this data would have been inherently documented when a purchase has been made" see column 4 lines 41-67 and column 5 lines 1-3 and 14-40)

register the face value in association with the serial number("i. e, "this data would have been inherently documented when a purchase has been made" see column 4 lines 41-67 and column 5 lines 1-3 and 14-40)

charge a credit card account associated with the credit card account number after

receiving the indication("i. e, verification") from.(see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

Berger fail to explicitly teach third party.

Berger fail to explicitly teach third party.

However Ginter discloses FIG. 16B shows that the usage clearinghouse may also provide services to other Commerce Utility Systems . In one example, the usage clearinghouse may provide raw data, aggregated data, at least in part derived information, and/or reports to other electronic commerce support services such as financial clearinghouses, rights and permissions clearinghouses, certifying authorities, secure directory services, transaction authorities, and other usage clearinghouses..(see column 104 lines 48-67 and column 105 lines 1-13).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger to include third party taught by Ginter in order to verify transactions.

As per claim 84, Berger discloses in which the instructions for directing the processor to receive an indication from the third party further comprises instructions configured to direct the processor to:  
determine if the serial number and face value information matches stored data; and  
transmit a verification code to the third party to validate the payment draft if the received information matches the stored data. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 85, Berger discloses 85 in which the instructions for directing the processor to receive user information further comprises instructions configured to direct the processor to receive at least one of a plurality of face value amounts, a number of payment drafts desired, and a date. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 86, Berger discloses further comprising instructions for directing the processor to:

determine if the user is found in a membership database; and prompt the user to register a copy of payment draft software if the user is not found in the membership database. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 87, Berger discloses a method, comprising:  
receiving from a user information including a credit card account number and a face value for a payment draft to be issued(see column 4 lines 41-67 and column 5 lines 1-3 and 14-40) transmitting to the user a registration code for use in generating the payment draft;  
receiving from the user a serial number associated with the payment draft("i. e, "this data would have been inherently documented when a purchase has been made" see column 4 lines 41-67 and column 5 lines 1-3 and 14-40)  
registering the face value and the serial number("i. e, "this data would have been inherently documented when a purchase has been made" see column 4 lines 41-67 and column 5 lines 1-3 and 14-40) and receiving an indication from and  
charging a credit card account associated with the credit card account number.(see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

Berger fail to explicitly teach third party.

However Ginter discloses FIG. 16B shows that the usage clearinghouse may also provide services to other Commerce Utility Systems . In one example, the usage clearinghouse may provide raw data, aggregated data, at least in part derived information, and/or reports to other electronic commerce support services such as financial clearinghouses, rights and permissions clearinghouses, certifying authorities, secure directory services, transaction authorities, and other usage clearinghouses..(see column 104 lines 48-67 and column 105 lines 1-13).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger to include third party taught by Ginter in order to verify transactions.

As per claim 88, Berger discloses 88 in which receiving an indication from the third party further comprises:

determining if the serial number and face value information matches stored data; and transmitting a verification code to the third party to validate the payment draft if the received information matches the stored data. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 89, Berger discloses 89, in which receiving user information further comprises receiving at least one of a plurality of face value amounts, a number of payment drafts desired, and a date. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 90, Berger discloses 90 further comprising: determining if the user is found in a membership database; and prompting the user to register a copy of payment draft software if the user is not found in the membership database. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 91, Berger discloses a computer readable medium storing instructions configured to direct a processor to:  
receive from a user information including a credit card account number and a face value for a payment draft to be issued. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40) transmit to the user a registration code ("i. e, verification") for use in generating the payment draft;

receive from the user a serial number associated with the payment draft register the face value and the serial number. ("i.e, inherently this data is stored when a purchase is made" see column 4 lines 41-67 and column 5 lines 1-3 and 14-40)

receive an indication from a of the serial number and the face value of the payment draft; and

charge a credit card account associated with the credit card account number.

.(see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

Berger fail to explicitly teach third party.

However Ginter discloses FIG. 16B shows that the usage clearinghouse may also



provide services to other Commerce Utility Systems . In one example, the usage clearinghouse may provide raw data, aggregated data, at least in part derived information, and/or reports to other electronic commerce support services such as financial clearinghouses, rights and permissions clearinghouses, certifying authorities, secure directory services, transaction authorities, and other usage clearinghouses..(see column 104 lines 48-67 and column 105 lines 1-13).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger to include third party taught by Ginter in order to verify transactions.

As per claim 92, Berger discloses in which the instructions for directing the processor to receive an indication from the third party further comprises instructions configured to direct the processor to:  
determine if the serial number and face value information matches stored data; and  
transmit a verification code to the third party to validate the payment draft if the received information matches the stored data. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 93, Berger discloses in which the instructions for directing the processor to receive user information further comprises instructions configured to direct the processor to receive at least one of a plurality of face value amounts, a number of payment drafts desired, and a date. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 94, Berger discloses further comprising instructions for directing the processor to:  
determine if the user is found in a membership database; and  
prompt the user to register a copy of payment draft software if the user is not found in the membership database. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 95, Berger discloses a method, comprising:  
transmitting to an issuer central controller a credit card account number and  
a face value for a payment draft to be issued; receiving a registration code;

inputting the registration code into a remote terminal running payment draft software;  
printing the payment draft, the printed payment draft including the face amount and a  
serial number;

transmitting the serial number to the issuer central controller for registration;

and receiving a verification code from the issuer central controller.

charge a credit card account associated with the credit card account number.

.(see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

Berger fail to explicitly teach third party.

However Ginter discloses FIG. 16B shows that the usage clearinghouse may also  
provide services to other Commerce Utility Systems . In one example, the usage  
clearinghouse may provide raw data, aggregated data, at least in part derived  
information, and/or reports to other electronic commerce support services such as  
financial clearinghouses, rights and permissions clearinghouses, certifying authorities,  
secure directory services, transaction authorities, and other usage clearinghouses..(see  
column 104 lines 48-67 and column 105 lines 1-13).

Therefore it would have been obvious to one of ordinary skill in the art at the time the  
invention was made to modify the teachings of Berger to include third party taught by  
Ginter in order to verify transactions.

As per claim 96, Berger discloses further comprising presenting the payment  
draft to a third party as compensation for goods or services. (see column 4 lines 41-67  
and column 5 lines 1-3 and 14-40).

As per claim 97, Berger discloses further comprising receiving an indication of a  
charge to the credit card account for the face value of the payment draft. (see column 4  
lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 98, Berger discloses further comprising, prior to transmitting a credit  
card account number, registering the payment draft software with the issuer. (see  
column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 99, Berger discloses a computer readable medium storing instructions  
configured to direct a processor to:  
transmit to an issuer central controller a credit card account number and a

face value for a payment draft to be issued; receive a registration code see column 4 lines 41-67 and column 5 lines 1-3 and 14-40)

input the registration code into a remote terminal running payment draft software;

print the payment draft, the printed payment draft including the face amount and a serial number (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40)

transmit the serial number to the issuer central controller for registration; and receive a verification code from the issuer central controller. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 100, Berger discloses further comprising instructions for directing the processor to receive an indication of a charge to a credit card account associated with the credit card account number for the face value of the payment draft. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

As per claim 101, Berger discloses, further comprising instructions for directing the processor to register the payment draft software with the issuer. (see column 4 lines 41-67 and column 5 lines 1-3 and 14-40).

### **Response to Arguments**

7. Applicant's arguments files on 10/ 18/2006 have been fully considered but they moot in view of new grounds of rejections.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

9. Applicant's claims 82-85, 91-95, 99-100, to be issued" processor to receive: states "to copy " configured to receive " configured to direct" prompt the user to register" However the subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does

not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04.

\*\*>USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous.

Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."<

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings."). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the

invention." Multiform Desiccants Inc. v. Medzam Ltd., 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also MPEP § 2111.01.

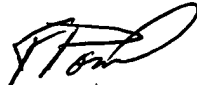
10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

Oct 15, 2007

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
